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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,901	01/22/2004	Joseph L. Pikulski	HRL/007-03	6163

7590 12/29/2005

AAGAARD & BALZAN, LLP
Suite 105
674 County Square Drive
Ventura, CA 93003

EXAMINER

JOHNSON, JONATHAN J

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,901

Applicant(s)

PIKULSKI, JOSEPH L.

Examiner

Jonathan Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 8-20 and 22-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

The examiner notes a typographical error in the species restriction of group I. In particular, the generic claims should be claims 1-3 and 19, not claims 1-3 and 21.

Applicants election of Group Ia is acknowledged. Applicant argues that the search can be made without an undue burden. The examiner disagrees. It is the examiner's position that the product can be made by a process that does not involve combining the microparticles with the solder alloy, but rather the perform could be made by a process having the discrete particles precoated with solder. This would require a search in class 438/617, which is not required for the product claims.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21 are drawn to a solder preform, classified in class 428, subclass various.
- II. Claims 22-44 are drawn to a method of forming a solder preform, classified in class 228, subclass 56.3.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the

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instant case the product can be made by a process that does not involve combining the microparticles but rather agglomerates during reflow.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

**IF APPLICANT ELECTS GROUP I, THEN APPLICANT MUST ADDITIONALLY
ELECT ONE OF THE FOLLOWING:**

This application contains claims directed to the following patentably distinct species of the claimed invention:

- Ia. Claims 4-7 are drawn to the amount of microparticles.
- Ib. Claims 8-10 and 20 are drawn to the composition.
- Ic. Claim 11 is drawn to the shape.
- Id. Claims 12-15 and 21 are drawn to the coefficient of expansion.
- Ie. Claims 16-18 are drawn to the distribution.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3 and 21 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**IF APPLICANT ELECTS GROUP II, THEN APPLICANT MUST ADDITIONALLY
ELECT ONE OF THE FOLLOWING:**

This application contains claims directed to the following patentably distinct species of the claimed invention:

- IIa. Claims 28 and 38 are drawn to the amount of microparticles.
- IIb. Claims 29 are drawn to the composition.
- IIc. Claims 27 and 30 are drawn to the shape.
- IId. Claims 31-33 and 42-44 are drawn to the coefficient of expansion.
- IIE. Claims 16-18 are drawn to the distribution.
- IIf. Claims 23-26, 35, 37 and 39-41 are drawn to the mixing.
- IIg. Claim 36 is drawn to the cooling.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 22 and 34 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0134976 (Keyser). Keyser teaches a solder matrix (paragraph 25); b) microparticles secured with the solder matrix (paragraph 25); and c) the microparticles being constructed so as to be capable of arranging during a solder bonding process so as to provide a substantially uniform separation between opposing soldered surfaces (paragraph 9 and 23); wherein the microparticles are embedded within the solder matrix (paragraph 25); wherein the microparticles are shaped so as to inhibit stacking while self arranging during a solder bonding process (paragraph 25); an amount of microparticles with respect to an amount of the solder matrix so as to inhibit stacking of the microparticles during a solder bonding process (paragraph 9 and 25); wherein the microparticles are shaped so as to inhibit stacking while self arranging during a solder bonding process (paragraph 9 and 25); wherein the microparticles comprise microspheres (paragraph 25); wherein the microparticles comprise at least one of: (a) glass; (b) plastic; (c) elastomer; (d) metal; (e) semiconductor; (f) material capable of conducting electric current; or (g) dielectric material (paragraph 25); and b) a plurality of microspheres having a substantially similar diameter embedded within the solder matrix (paragraph 25 and figure 5, item 24).

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Johnson whose telephone number is 571-272-1177. The examiner can normally be reached on M-Th 7:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jonathan Johnson
Primary Examiner
Art Unit 1725

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